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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/637,086	08/11/2000	Karen L. Fincher	38-21(51375)B	8111

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EXAMINER

MORAN, MARJORIE A

ART UNIT	PAPER NUMBER
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1631

DATE MAILED: 12/03/2001

6

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/637,086

Applicant(s)

FINCHER ET AL.

Examiner

Morjorie Moran

Art Unit

1631

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-9 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: *detailed action/seq list*.

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claim 1, drawn to a purified nucleic acid molecule, classified in class 536, subclass 23.6.
- II. Claim 2, drawn to a purified cotton protein, classified in class 530, subclass 370.
- III. Claims 3-9, drawn to a transformed plant, classified in class 435, subclass 419.

The inventions are distinct, each from the other because of the following reasons:

Group I is separate and distinct from Group II because the inventions are directed to different chemical types regarding the critical limitations therein. For Group II, the critical feature is a polypeptide whereas for Group I the critical feature is a polynucleotide. It is acknowledged that various processing steps may cause a polypeptide of group II to be directed as to its synthesis by a polynucleotide of Group I, however, the completely separate chemical types of the inventions of Groups I and II supports the undue search burden if both were examined together. Additionally, polypeptides have been most commonly, albeit not always, separately characterized and published in the Biochemical literature, thus significantly adding to the search burden if searched together, as compared to being searched separately. Also, it is pointed out that although processing may connect two groups, such a connection does not prevent them from being viewed as distinct, because enough processing can result in producing any composition from any other composition if the processing is not so limited to additions, subtractions, enzyme actions, etc.

Groups I and III are separate and distinct. The Groups are related in that the plants of Group III comprise a nucleic acid molecule of Group I. However, plants are different biochemical entities products than are nucleic acids, with very different properties, and would be expected to behave differently in methods of use. As the plants of Group III and the nucleic

acids of Group I are different and distinct products for the reasons set forth, Groups I and III are separate and distinct.

Groups II and III are not related. The plants of Group III are not limited to comprise or produce a polypeptide of Group II, and the polypeptides of Group II are not limited to be those produced by or purified from the plants of Group III, therefore Groups II and III are unrelated.

These inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, because of their recognized divergent subject matter, therefore restriction for examination purposes as indicated is proper. Because these inventions are distinct for the reasons given above and the search required for Groups II and III is not required for Group I, and the search required for Group III is not required for Group II, restriction for examination purposes as indicated is proper.

Sequence Election Requirement Applicable to All Groups

In addition, each Group detailed above reads on patentably distinct Groups drawn to multiple SEQ ID Numbers. The sequences are patentably distinct because they are unrelated sequences and each unrelated sequence is considered a separate and distinct product, therefore a further restriction is applied to each Group. For an elected Group drawn to either amino acid or polypeptide sequences, the applicant must further elect a **single** amino acid or a **single** polypeptide sequence. (See MPEP 803.04). Due to the increasingly large size of sequence databases which must be searched and the increasing numbers of applications requiring sequence searches, it creates an undue burden on the Office to search more than a single sequence (product) per application. For these reasons, the requirements of 37 CFR 1.141 et seq. are no longer waived and applicant is required to elect a single sequence for

examination. Applicant is reminded that this is a restriction requirement, not an election of species.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention and the SEQ ID number to be examined even though the requirement be traversed (37 CFR 1.143). Applicant is further advised that any reply to the restriction requirements will be considered NONRESPONSIVE unless the sequence requirements have been fully met. See below.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(l).

Sequence Requirements

This application contains sequence disclosures that are encompassed by the definitions for nucleotide and/or amino acid sequences set forth in 37 CFR 1.821(a)(1) and (a)(2). A computer readable form (CRF) of the sequence listing was submitted. However, the CRF could not be processed by the Scientific and Technical Information Center (STIC) for the reason(s) set forth on the attached CRF Diskette Problem Report. Applicant must comply with the requirements of the sequence rules (37 CFR 1.821 - 1.825) before the application can be examined under 35 U.S.C. §§ 131 and 132.

Applicant is given THREE MONTHS from the mailing date of this communication within which to comply with the sequence rules, 37 CFR 1.821 - 1.825, said time to comply to run

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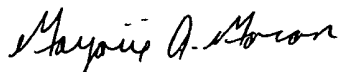
concurrently with the time to respond to the restriction requirements set forth above. Failure to comply with these requirements will result in ABANDONMENT of the application under 37 CFR 1.821(g). Extensions of time may be obtained by filing a petition accompanied by the extension fee under the provisions of 37 CFR 1.136(a). Direct the reply to the undersigned. Applicant is requested to return a copy of the attached CRF Diskette Problem Report with the reply.

Applicant is again advised that any reply to the restriction requirements will be considered NONRESPONSIVE unless the sequence requirements have been fully met.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marjorie A. Moran whose telephone number is (703) 305-2363. The examiner can normally be reached on Monday to Friday, 7:30 am to 4 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on (703) 308-4028. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4556 for regular communications and (703) 308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to a patent analyst, Dianiece Jacobs, whose telephone number is (703) 305-3388.



Marjorie A. Moran
Patent Examiner
November 27, 2001